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REMARKS

Claims 1-84 were originally presented in the subject application. Claims 3, 11, 16, 31, 39, 44, 59, 67 and 72 were amended, and claims 85-112 added in an Amendment and Response to Office Action dated November 17, 2004. Claims 1, 29, 57 and 85 have herein been amended to more particularly point out and distinctly claim the subject invention. No claims have herein been added or canceled. Therefore, claims 1-112 remain in this case.

The addition of new matter has been scrupulously avoided. In that regard, support for the common amendment to the claims can be found in the specification at, for example, page 3, line 16 in the Summary of the Invention.

Applicants respectfully request entry of these amendments and remarks, and reconsideration and withdrawal of the grounds of rejection and objection.

37 CFR 1.105 Requested Information

The final Office Action requested any publications describing ERPNet, as demonstrated in the demos noted in the PR Newswire item about Candle Corporation. As noted in the prior response, other than the press release (the PR Newswire item), no published information regarding the service was found. Therefore, the item is unknown or cannot be readily obtained.

35 U.S.C. §112 Rejection

The Office Action rejected claims 85-112 under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. In particular, the final Office Action alleged that the "capable of performing" language in claim 85 was indefinite.

Applicants respectfully disagree that the noted language is indefinite. Applicants submit that a computing system is not inherently capable of performing anything, unless and until it is programmed to do so. Nonetheless, in an attempt to advance prosecution, Applicants have amended claim 85 to recite "adapted to perform," rather than the objectionable language.

As amended, Applicants submit claim 85 overcomes the stated rejection.

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35 U.S.C. §102 Rejection

The final Office Action maintained the rejection of claims 1-7, 10, 11, 15, 16, 23, 29-35, 38, 39, 43, 44, 51, 57-63, 66, 67, 71, 72, 79, 85-91, 94, 95, 99, 100 and 107 under 35 U.S.C. §102(e), as allegedly anticipated by Cohen et al. (U.S. Patent No. 6,286,028). The final Office Action also rejected claims 1-7, 10, 11, 14-17, 22-27, 29-35, 38, 39, 42-45, 50-55, 57-63, 66, 67, 70-73, 78-83, 85-91, 94, 95, 98-101 and 106-111 under 35 U.S.C. §102(b), as allegedly anticipated by ERPNet, disclosed in Applicant's IDS as Dialog File 20, accession No. 02821200. Applicants respectfully, but most strenuously, traverse both of these rejections.

In response, Applicants have amended claims 1, 29, 57 and 85 to replace the "while the user waits" language with --in real time--, which was the intent of the original language.

With respect to an anticipation rejection, it is well settled that a claimed invention is not anticipated unless a single prior art reference discloses: (1) all the same elements of the claimed invention; (2) found in the same situation as the claimed invention; (3) united in the same way as the claimed invention; (4) in order to perform the identical function of the claimed invention.

Cohen et al.

Amended claim 1 recites, for example, obtaining a reply within the private electronic environment in response to the communication (from the user) *in real time*.

The final Office Action does not cite to any section of Cohen et al. disclosing the same. Applicants could find no disclosure in Cohen et al. that a reply from the back end is obtained in real time. In general, there is discussion in Cohen et al. of a user transacting business at the front end, and that some of the information obtained from the user must be shared with the back end application, but Applicants could find no express disclosure of a reply provided from the back end or a time frame therefor.

If Cohen et al. suggests anything that might be construed as relevant to the noted aspect of claim 1, Applicants submit that such would have to be part an obviousness (section 103) rejection. However, both Cohen et al. and the present application are assigned to IBM. At the time the present invention was filed, both Cohen et al. and the present application were assigned to or subject to an obligation of assignment to IBM. Thus, under 35 U.S.C. §103(c), since Cohen

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et al. qualifies as prior art only under § 102(e), Cohen et al. cannot be cited as part of an obviousness rejection against the present application.

Therefore, Applicants submit that claim 1 cannot be anticipated by Cohen et al., nor can Cohen et al. properly be cited as part of an obviousness rejection.

Claims 29, 57 and 85 contain a limitation similar to that argued above with respect to claim 1. Thus, the arguments made above regarding claim 1 are equally applicable thereto. Therefore, claims 29, 57 and 85 also cannot be anticipated by, or made obvious over, Cohen et al.

ERPNet

Similarly, Applicants could find no disclosure, teaching or suggestion in ERPNet of obtaining a reply within a private electronic environment in response to a user communication in real time. In addition, again the final Office Action fails to even mention this aspect of the claims, nor cite to any section of ERPNet as allegedly disclosing, teaching or suggesting the same.

Therefore, Applicants submit that none of independent claims 1, 29, 57 or 85 can be anticipated by, or made obvious over, ERPNet.

Double Patenting

The final Office Action advised that if claims 1-28 were found allowable, claims 85-112 would be objected to under 37 CFR 1.75, as allegedly a substantial duplicate thereof. Further, the final Office Action alleged that there were only "slight differences in wording," citing MPEP 706.03(k).

Applicants respectfully point out, however, that claim 85 recites, after "comprising," the aspect of "integrating computer-readable code into a computing system." This aspect of claim 85 is nowhere to be found in claim 1, and Applicants have rearranged claim 85 to better identify this aspect. Thus, claim 1 and claim 85 clearly differ in scope. According to the MPEP section cited in the final Office Action, "a mere difference in scope between claims has been held to be enough" to overcome such an objection.

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Moreover, claim 1 recites a method for synchronous communications between a public electronic environment and a private electronic environment, while claim 85 recites a method for providing a computing infrastructure. Still further, claim 85 recites that "the computer code in combination with the computing system is adapted to perform...", which again is not present in claim 1.

Applicants submit that the differences noted above are clearly more than slight differences in wording, such that claim 85 is not a substantial duplicate of claim 1.

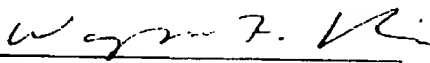
CONCLUSION

Applicants submit that the dependent claims are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations.

For all the above reasons, Applicants maintain that the claims of the subject application define patentable subject matter and earnestly allowance of claims 1-112.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,



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